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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,251	05/04/2006	Tomohiro Yamada	060353	6704
23850 7590 03/31/2008 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005				
EXAMINER				
BATISTA, MARCOS				
ART UNIT		PAPER NUMBER		
4134				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,251

**Applicant(s)**

YAMADA ET AL.

**Examiner**

MARCOS BATISTA

**Art Unit**

4134

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CS-100)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 05/04/2006

## DETAILED ACTION

### *Claim Objections*

1. Claim 5 is objected to because of the following informalities: The word "address" in line 3 of claim 5 appears to be confused with the word access. This claim is being analyzed based on that observation. Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 7 defines a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Pattabiraman et al. (US 20030195010 A1).

Consider claim 1, Pattabiraman discloses a wireless communication terminal (106C) for setting connection information required for wireless connection to an access

point (104) of a network to a specific wireless communication terminal (106D), comprising: an acceptance means for accepting a terminal identifier for identifying said specific wireless communication terminal (see [0028], [0030], [0044], [0046]). Pattabiraman also discloses a connection means for connecting to said specific wireless communication terminal based on the terminal identifier accepted by said acceptance means (see fig. 3 #310, [0028], [0030], [0047]). Pattabiraman further discloses a transfer means for transferring said connection information to said specific wireless communication terminal after connection by said connection means (see fig. 1, [0052]).

Consider claim 2, Pattabiraman discloses wherein said specific wireless communication terminal has an electronic certificate of authentication by an authentication terminal connected to said network (see fig. 2 #270, [0042], [0046] – the identify module contains authentication information: electronic certificate). Pattabiraman also discloses wherein said wireless communication terminal further comprises: an acquisition means for acquiring said electronic certificate from said specific wireless communication terminal after the connection by said connection means (see fig. 3 #330, [0046]). Pattabiraman further discloses a determination means for determining whether said specific wireless communication terminal is an authorized terminal or not based on said electronic certificate acquired by said acquisition means, and said transfer means transfers said connection information when result of determination by said determination means is affirmative (see [0032], [0047], [0052] –

connection set up involves authentication and registration, which implies that service is granted on the basis of the authentication and/or registration).

Consider claim 3, Pattabiraman discloses wherein said electronic certificate contains an address of said authentication terminal, and said determination means includes an access means for accessing said authentication terminal according to said address and a request means for requesting said authentication terminal to authenticate said specific wireless communication terminal (see fig. 1, [0047], [0052]).

Consider claim 4, Pattabiraman discloses wherein said connection information includes an access point identifier for identifying said access point (see fig. 1, [0032], [0052]).

Consider claim 5, Pattabiraman discloses wherein said connection information includes encryption key information for carrying out encrypted communication with said access point (see [0032], [0042] – shared secret information is a form of encrypted communication).

Consider claim 6, this is a method claim corresponding to apparatus claim 1. Therefore, it has been analyzed and rejected based upon the apparatus claim 1 above.

Consider claim 7, Pattabiraman discloses a connection information setting program executed by a processor of a wireless communication terminal for setting

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connection information required for wireless connection to an access point of a network to a specific wireless communication terminal, comprising: an acceptance step of accepting a terminal identifier for identifying said specific wireless communication terminal; a connection step of connecting with said specific wireless communication terminal based on the terminal identifier accepted in said acceptance step; and a transfer step of transferring said connection information to said specific wireless communication terminal after the connection in said connection step (see fig. 3, 4 and 5, [0058], [0060]).

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marcos Batista, whose telephone number is (571) 270-5209. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lun-Yi Lao can be reached at (571) 272-7671. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Marcos Batista*  
/M. B./  
03/19/2008



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Supervisory Patent Examiner, Art Unit 4134